

REMARKS

This Amendment is in response to the Official Action mailed June 8, 2007. Claims 35 and 53 have been amended. Claims 31-46, 52-70 and 72 as pending are presented for consideration in view of the following remarks.

Group A Claims (Independent Claims 31, 41, 68, 69)

The Examiner has rejected all of the independent claims of Group A (i.e., claims 31, 41, 68 and 69), and their dependent claims 32-40, 42-46 and 70, as obvious over Browne, Lenihan, Suga and Ohara, four previously cited references, in view of a fifth, new reference, Sparks et al., U.S. Publication No. 2002/0018638 ("Sparks").¹

The Examiner has repeated his arguments as to Browne, Lenihan, Suga and Ohara from the prior Official Action mailed July 31, 2006. The Examiner now relies on Sparks for allegedly disclosing the feature of preventing the display of the received digital broadcasting signal only during display of the control panel information. (Office Action at 6.) To support this statement, the Examiner takes a position that since Sparks does not have complete digital decoding and manipulation functionality, when the apparatus is in the analog recording mode it "prevents the outputting of digital data when the control information is presented" (*Id.*)

This quoted statement by the Examiner, however, is not what is being claimed in the Group A claims. Rather, the claims of Group A (e.g., claim 31) call for:

wherein when said external recording apparatus is in the digital recording mode, the digital broadcasting signal is displayed whether or not the control panel information is displayed, and wherein when said external recording apparatus is in the analog

¹ On page 2 of the Office Action, the Examiner mistakenly included claims 47-49 and 51 with the range of his rejection. These claims, however, had been previously cancelled.

recording mode, said display processing circuit **prevents the display of the received digital broadcasting signal** only during display of said control panel information.

That is to say, the presently claimed invention of Group A deals with the display or nondisplay of the *broadcasting signal* being received and shown -- depending on whether the control panel information is being displayed -- not with what is being played back from the recording apparatus. Thus, the Examiner's statement that analog recording of Sparks prevents the outputting of digital data is not applicable to the matter of display of the *broadcasting signal* being received.

In Sparks, in its analog recording mode, the DVCR 200 records analog input signals. It can then output such analog signals to the display 300. In the digital recording mode, the DVCR 200 records digital input signals in digital form. It can then output such digital signals to IRD 100 where they are decoded and placed into analog form for display on display 300. In either case, on-screen display (OSD) information can be mixed in with the signal, either by the DVCR 200 or IRD 100, to be output to the display 300.

Unlike the present invention, when Sparks is in the analog recording mode, there is no mechanism or step to prevent the display of the A/V OUT signal 101 when control panel (or OSD) information is displayed. This is because Sparks does not address the problem solved by Applicants; namely, that users may become confused if they try to record a digital broadcasting signal being viewed using a combined digital/analog recording device, when that combined recording device is in the analog recording mode. To solve this problem, if the user displays the control panel in an effort to try to record the digital broadcasting signal that the user is watching, and the recorder is in the analog recording mode, the digital input picture will

not be displayed, and, for example, will be shown as a "gray" signal as indicated in Fig. 4A.

Thus, combining the prior art as suggested by the Examiner does not produce, or render obvious, the claimed invention of the Group A claims. Applicants therefore request that the rejection of the Group A claims be withdrawn.

Group B Claims (Independent Claims 35 and 53)

The Examiner has rejected the independent claims of Group B (i.e., claims 35 and 53), and dependent claims 36-37, 39, 54, 55 and 57, as obvious over Browne, Suga, Ohara and Ellis, four previously cited references, in view of a fifth, new reference of Hashimoto, U.S. Pat. No. 5,990,949 ("Hashimoto").

With respect to the claims of Group B, the Examiner addresses claim 35 at pages 19-22 and claim 53 at pages 23-25 of the Official Action. As to claim 35, the Examiner reiterates his grounds of rejection based on Browne, Suga, Ohara and Ellis. The Examiner now also relies on Hashimoto with respect to the claimed feature of "displaying an alarm message upon an attempted reproduction of a program recorded in the analog mode when the external reproducing apparatus is in the digital reproduction mode." (Official Action at 22.)

Hashimoto does not disclose this claimed display feature. Hashimoto is directed to a computer video monitor *adjustment* system that provides a microprocessor and on-screen display circuit to allow a user to *adjust the picture quality* of the monitor based on various overlays of messages for *picture adjustment*. It also allows adjustment of on-screen picture size based on, for example, timing measurements. When no video input signal is detected, an error message (Fig. 14B) is shown. Or, if the horizontal and/or vertical scanning frequencies are outside the monitor's range, a different error message (Fig. 14A) is shown.

In Hashimoto, no error or alarm message is shown upon any attempted reproduction by the IRD decoder of an analog-mode recorded program that can be played back by an external, dual mode (analog or digital) reproducing apparatus placed in its digital reproduction mode. Hashimoto is not concerned with the problems of analog or digital recordings and their interaction with a digital receiver that receives a digital signal from a dual mode (digital or analog) external reproducing apparatus. Rather, Hashimoto is concerned with adjusting the picture of the input video signal and merely presents error messages if no video signal is present (Fig. 14B) or if its scanning frequencies are out of range (Fig. 14A).

Thus, the combination of all of the cited references does not produce or render obvious the claim invention of the Group B claims including the feature (e.g., claim 35) of "displaying an alarm message upon attempted reproduction from the external recording apparatus, through the receiving apparatus, of a program recorded in the analog mode when the external reproducing apparatus is in the digital reproduction mode." Applicants therefore request that the rejection of the Group B claims be withdrawn.

Again, as pointed out in Applicants' preliminary amendment dated March 13, 2007, claims 36 and 37 (and corresponding claims 54 and 55) are additionally unique and patentable over the prior art as they provide specific alarm messages which are not disclosed in the cited references or Ellis. In dependent claim 36, the alarm message indicates that a new station cannot be selected by the user during digital recording. Further, dependent claim 37 indicates that a new station cannot be selected in analog recording mode in display of the control panel. On page 22 of this Official Action, however, the Examiner has continued to reject claims 36 and 37 based on old, cancelled language from those claims which originally had

limitations related to channel number, program name, genre, etc. (see old claim 36) and information including recording position (see old claim 37). The same is true with respect to claims 54 and 55. These claims were previously amended and thus the Examiner's rejection of these claims is inapplicable and should be withdrawn.

Group C Claims (Independent Claims 52, 58, 63 And 72)

Finally, as to the Group C claims (52, 58, 63 and 72), the Examiner repeats his prior arguments to reject these claims based on a combination of Browne, Lenihan, Suga and Ohara (Official Action at 28-30) and now adds the new, fifth reference of Hashimoto, which Applicants have discussed above.

The Examiner contends, based on Hashimoto, that it would have been obvious to modify the combined teachings of the prior art with displaying of an alarm or message if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer so as to notify the user of any problem that might arise in program recording/reproduction. (Office Action at 30-31.)

Again, with Hashimoto, no error or alarm message is shown upon any attempted reproduction by the IRD of a digitally recorded program due to the inability to decode the signal in the IRD. The claims of Group C specify that there is a program recorded on the recording medium but that it cannot be decoded in the decoder. Hashimoto is not concerned with this problem of inability to decode a properly recorded program by the decoder. Rather, Hashimoto is concerned with adjusting the picture of the input video signal and merely presents error messages if no video signal is present (Fig. 14B) or if its scanning frequencies are out of range (Fig. 14A).

The combined prior art references therefore do not meet the limitation (e.g., claim 52) of: "wherein in the case where a digital signal reproduced by said reproducing apparatus

and received through said digital interface *is not able to be decoded in said decoder, said display processing circuit performs a display process so as to display a message showing that the program recorded on the recording medium loaded in said reproducing apparatus is recorded in a recording mode in which said digital signal cannot be decoded by said receiving apparatus of said digital broadcasting.*"

Thus, Applicants request that the rejection of the Group C claims also be withdrawn.

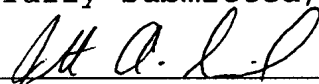
In view of the above, it is respectfully submitted that these amendments and remarks place the application in condition for immediate allowance. If, however, for any reason the Examiner does not believe such action can be taken, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any objections which he may have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge applicants' Deposit Account No. 12-1095 therefor.

Dated: August 7, 2007

Respectfully submitted,

By



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